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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
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R. Thomas Payne  
CUMMINGS & LOCKWOOD  
Four Stamford Plaza  
Stamford, CT 06904

In re Application of :  
LINDBO, Sverker :  
U.S. Application No.: 09/445,845 :  
PCT No.: PCT/US99/21248 :  
Int. Filing Date: 22 September 1999 :  
Priority Date: 24 September 1998 :  
Attorney's Docket No.: 639321.0005 :  
For: AN INTERNET CACHING SYSTEM :  
AND A METHOD AND AN :  
ARRANGEMENT IN SUCH A SYSTEM :

DECISION

The decision is in response to applicant's "Renewed Petition Under 37 CFR §1.47(b)" submitted 11 June 2001 requesting that the United States Patent and Trademark Office accept a declaration without the signature of the sole inventor.

### **BACKGROUND**

On 12 December 2000, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed. Applicant did not provide satisfactory evidence that the inventor refused to execute the declaration and the declaration submitted by the 37 CFR 1.47(b) applicant did not comply with 37 CFR 1.497 and 37 CFR 1.63.

On 24 April 2001, applicant submitted the instant renewed petition which was accompanied by, *inter alia*, a four-month extension of time and fee, a declaration signed by Timo Aittola as the 37 CFR 1.47(b) applicant, a copy of an assignment and English translation signed by Mr. Lindbo, a declaration titled "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor Pursuant to 37 C.F.R. § 1.47(b)" signed by Mr. Aittola ("Aittola Decl."), a declaration titled "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor Pursuant to 37 C.F.R. § 1.47(b)" signed by R. Thomas Payne ("Payne Decl."), and two declarations titled "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor Pursuant to 37 C.F.R. § 1.47(b)" signed by Mary Jo Johnson, and a copy of the application with a cover letter sent to Mr. Shub, one of the attorneys representing Mr. Lindbo.

### **DISCUSSION**

As previously stated, a petition under 37 CFR 1.47(b) must include (1) the \$130.00 petition fee, (2) factual proof that the inventor refuses to execute the application, (3) a statement of the last known address of the inventor, (4) an oath or

declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor(s), (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. In the original petition, applicant failed to satisfy items (2) and (4) of 37 CFR 1.47(b).

In the instant renewed petition, applicant has submitted a new declaration signed by Mr. Aittola which meets the requirements of 37 CFR 1.497 and 37 CFR 1.63. Therefore, item (4) is satisfied.

Concerning item (2), applicant has included declarations by Mr. Aittola, the Chief Financial Officer of Mirror Image Internet, Inc., R. Thomas Payne, attorney for applicant, and two declarations by Mary Jo Johnson another attorney for applicant.

In the original petition, applicant failed to show that Mr. Lindbo was presented with a complete copy of the application papers including specification, claims, drawings, and oath or declaration. Here, Ms. Johnson states in paragraph four of one of her declarations that on 09 May 2001 a paralegal delivered to Mr. Lindbo's attorney's "a copy of the application and associated Oath/Declaration under cover letter from T. Thomas Payne, Cummings & Lockwood." Mr. Payne confirmed this account in his declaration. Payne Decl. ¶ 4. A copy of the application and cover letter hand delivered to Mr. Lindbo's attorney's was also submitted. Thus, applicant has shown that Mr. Lindbo has been presented with a complete copy as required in section 409.03(d) of the Manual of Patent Examining Procedure (MPEP).

Applicant also failed to show that Mr. Lindbo refused to sign the documents in the original petition. Here in the renewed petition, Mr. Aittola described the actions taken place after the dismissal of the original petition. Mr. Aittola recounts that settlement discussions "finally broke down around the end of April 2001 when Mr. Lindbo (through his counsel) rejected any use of an escrow, that did not involve an immediate cash payment to Parfi of \$160,000." Aittola Decl. ¶ 12. Ms. Johnson states in paragraph five of one of her two declarations that on 10 May 2001, she contacted Ms. Busny an attorney for Mr. Lindbo, who told her "that Mr. Lindbo would not sign the relevant documents unless Mirror Image Internet, Inc. paid \$160,000 to Parfi AB." Ms. Johnson then states in paragraph six that she informed Ms. Busny that Mirror Image would not pay the \$160,000 and requested that Ms. Busny attempt to have her client sign the papers anyway. Finally, Ms. Johnson states that she "has not heard from Ms. Busny since that conversation and has not received any message that Ms. Busny has attempted to reach the undersigned as of the execution of this document." Mr. Payne also claims that [o]n June 6, 2001, after placing a telephone call to Elise Busny, one of Mr. Lindbo's attorneys, Elise Busny clearly stated that Mr. Lindbo would not sign the declaration. Payne Decl. ¶ five. These declarations are sufficient to show that Mr. Lindbo refuses to execute the declaration. Therefore, item (2) is also satisfied.

Accordingly, applicant has met all of the requirements of 37 CFR 1.47(b).

**CONCLUSION**

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 08 September 2000, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 22 September 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **11 June 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



Leonard Smith  
PCT Legal Examiner  
PCT Legal Office



James Thomson  
Attorney Advisor  
PCT Legal Office

Tel.: (703) 308-6457



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Sverker Lindbo  
40 Elm Street  
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ARRANGEMENT IN SUCH A SYSTEM

Dear Mr. Lindbo:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. § 118. Should a patent be granted, you will be designated as the inventor.

As the inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard Smith  
PCT Legal Examiner  
PCT Legal Office

James Thomson  
Attorney Advisor  
PCT Legal Office

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